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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

LOTES CO., LTD.,
Plaintiff and Counterclaim Defendant,
v.
HON HAI PRECISION INDUSTRY CO.,
LTD., and FOXCONN ELECTRONICS, INC.,
Defendants and Counterclaimants.

Case No. 4:11-cv-01036 JSW

**JOINT STATUS REPORT
REGARDING CURRENT STATUS
OF REEXAMINATION
PROCEEDINGS**

Pursuant to the Court's January 4, 2012 Order (D.I. 73) requiring Hon Hai Precision Industry Co. Ltd. and Foxconn Electronics, Inc. (collectively "Foxconn") and Lotes Co. Ltd. ("Lotes") (collectively "the Parties") to "submit a joint status report regarding the status of the reexamination proceedings every 120 days, or sooner if the PTO issues a final decision with respect to the Newly Asserted Patents, until the stay is lifted," the Parties hereby advise the Court of the current status of the reexaminations of each of the asserted patents subject to the partial stay ordered by the Court.

1 A list of the asserted patents for which a reexamination request had been filed and a brief
2 summary of each patent's status is provided below. No reexamination request has been filed with
3 respect to two patents, namely U.S. Patent Nos. 6,679,717 and 5,634,803.

4 **NEWLY ASSERTED PATENTS**

5 **U. S. Patent No. 5,882,211**

6 Lotes filed a Reexamination Request for U.S. Patent No. 5,882,211 ("the '211 patent") on
7 March 24, 2011, as Ex Parte Reexamination No. 90/009,885. The examiner issued a Notice of
8 Intent to Issue a Reexamination Certificate on July 24, 2012. A Reexamination Certificate issued
9 on September 4, 2012. Claims 1 and 10 are determined to be patentable as amended. Claims 5-7,
10 dependent on an amended claim, are determined to be patentable. New claims 13-14 are added
11 and determined to be patentable. Claims 2-4, 8, 9, 11 and 12 have been cancelled. The
12 reexamination proceedings concerning the '211 patent, including any appeals, are completed, and
13 the reexamination decision is final.

14 **U. S. Patent No. 6,113,398**

15 Lotes filed a Reexamination Request for U.S. Patent No. 6,113,398 ("the '398 patent") on
16 March 17, 2011, as Ex Parte Reexamination No. 90/009,887. The examiner issued a Notice of
17 Intent to Issue a Reexamination Certificate on April 6, 2012. The examiner issued a
18 Reexamination Certificate on May 29, 2012. Claims 1, 4, and 6 are determined to be patentable
19 as amended. Claims 2, 3, 5, and 7, dependent on an amended claim, are determined to be
20 patentable. New claims 8-16 are added and also determined to be patentable. The reexamination
21 proceedings concerning the '398 patent, including any appeals, are completed, and the
22 reexamination decision is final.

23 **U. S. Patent No. 6,135,791**

24 Lotes filed a Reexamination Request for U.S. Patent No. 6,135,791 ("the '791 Patent") on
25 November 1, 2011, as Ex Parte Reexamination No. 90/011,995. The examiner issued a Notice of
26 Intent to Issue a Reexamination Certificate on June 15, 2012. The examiner issued a
27 Reexamination Certificate for the '791 Patent on August 14, 2012. The patentability of claims 1-
28 8 is confirmed. No amendments were made to the patent claims. The reexamination proceedings

1 concerning the '791 patent, including any appeals, is completed, and the reexamination decision
2 is final.

3 **U. S. Patent No. 6,530,798**

4 Lotes filed a Reexamination Request for U.S. Patent No. 6,530,798 on January 6, 2011, as
5 Ex Parte Reexamination No. 90/009,869. The examiner, in a Final Action on January 19, 2012,
6 confirmed the patentability of claim 6 and rejected claims 1-5 and 7-25. Foxconn filed a Notice
7 of Appeal on May 18, 2012. Foxconn filed its Appeal Brief on July 18, 2012. The examiner filed
8 an Answer to Foxconn's Appeal Brief on February 6, 2013. Foxconn filed a response to the
9 Examiner's Answer on April 8, 2013. The Board issued a decision on June 27, 2013 confirming
10 the rejection of claims 1-5 and 7-25 and the patentability of claim 6. On August 26, 2013,
11 Foxconn requested a rehearing, which was denied on March 20, 2014. Foxconn filed a notice of
12 appeal with the U.S. Court of Appeals for the Federal Circuit on May 16, 2014. Foxconn
13 subsequently dismissed the appeal. On October 22, 2014, the Patent Office issued a
14 reexamination certificate cancelling claims 1-5. Thus, the reexamination proceedings concerning
15 the '798 patent, including any appeals, are completed, and the reexamination decision is final,
16 with one claim (claim 6) confirmed.

17 Foxconn filed a reissue request on July 18, 2014, requesting reissue of claims 1-20. Lotes
18 filed a protest on October 21, 2014, on the grounds that claims 1-5 were previously prosecuted
19 and rejected in a reexamination proceeding that is now final. Foxconn filed a preliminary
20 amendment canceling claims 1-5, leaving original claim 6 (amended to include the limitations of
21 other claims) and new claims 7-20. All claims are currently rejected. A response to the office
22 action is due on May 18, 2015.

23 **U. S. Patent No. 6,905,353**

24 Lotes has filed three reexamination requests for U.S. Patent No. 6,905,353 ("the '353
25 Patent"). Lotes filed the first Reexamination Request on July 25, 2011, as Ex Parte
26 Reexamination No. 90/009,928. The examiner issued a Reexamination Certificate on August 21,
27 2012 confirming the patentability of amended claims 1-17 and newly added claims 18-47. The
28 reexamination proceedings pursuant to this request has concluded.

1 Lotes filed a second Reexamination Request for the '353 Patent on March 5, 2013, as Ex
 2 Parte Reexamination No. 90/012,804. On July 5, 2013, the examiner responded, rejecting claims
 3 1-3, 6-8, 14-20, 23-25, 31-38, and 41-47 and confirming the patentability of claims 4, 5, 9-13, 21,
 4 22, 26-30, 39 and 40. Foxconn filed a response on September 5, 2013, adding claims 48-117 and
 5 amending claims 16, 17, 33, and 34. On November 25, 2013, the examiner responded by issuing
 6 a Notice of Intent to Issue Reexamination Certificate in which original claims 1-15, 18-32, and
 7 35-47, claims 16, 17, 33, and 34 were allowed as amended, and new claims 48-117 were allowed.

8 Lotes filed a third Reexamination Request on the '353 Patent on February 12, 2014, as Ex.
 9 Parte Reexamination No. 90/013,151. The Patent Office granted the request on March 12, 2014.
 10 The examiner issued a non-final office action on June 18, 2014, rejecting claims 1-117. Foxconn
 11 filed a response to the Office Action on August 18, 2014. On October 21, 2014, the Patent Office
 12 issued a Final Office Action rejecting claims 1-15 and 91-92 and confirming as patentable claims
 13 16-90 and 93-117. On November 26, 2014, Foxconn filed a response to the Final Office Action.
 14 On December 10, 2014, the Patent Office issued a Notice of Intent to Issue Reexamination
 15 Certificate for US Patent No. 6,905,353. All 117 claims have been confirmed or deemed
 16 patentable, as amended.

17 **U. S. Patent No. 6,908,316**

18 Lotes has filed two reexamination requests for U.S. Patent No. 6,908,316 ("the '316
 19 Patent"). Lotes filed the first Reexamination Request on November 2, 2010, as Ex Parte
 20 Reexamination No. 90/009,831. The examiner issued a Reexamination Certificate for the '316
 21 Patent on February 28, 2012. The examiner determined that amended claim 19 and newly added
 22 claims 20-57 were patentable. Claims 1-18 were cancelled. The reexamination proceedings
 23 pursuant to this request has concluded.

24 Lotes filed a second Reexamination Request for the '316 Patent on April 11, 2012, as Ex
 25 Parte Reexamination No. 90/012,250. The examiner issued a first office action on September 25,
 26 2012, in which claims 20 and 21 were confirmed as patentable and claims 19 and 22-57 were
 27 rejected. Foxconn filed a response to the office action on November 26, 2012, through which
 28 claims 19, 22, 27-30, 37-40, 45-48, and 55-57 were amended and claims 58-61 added. The

1 examiner issued an Advisory Action on June 25, 2013, rejecting claims 19 and 22-57 and
2 confirming the patentability of claims 20, 21, and 58-61.

3 Foxconn filed a Notice of Appeal on July 3, 2013, and filed an appeal brief on September
4 3, 2013. The examiner filed an Answer to Foxconn's Appeal Brief on November 26, 2013,
5 arguing that the rejections should be sustained, and Foxconn's Reply Brief was filed on January
6 27, 2014. The PTAB issued an Order on May 6, 2014, reversing the Examiner's rejections. The
7 examiner issued a Reexamination Certificate for the '316 Patent on July 2, 2014. The examiner
8 confirmed the patentability of claims 20 and 21, determined that amended claims 19, 22, 27-30,
9 37-40, 45-48 and 55-57 were patentable as amended, and determined that claims 23-26, 31-36,
10 41-44, and 49-54 (dependent on an amended claim), and newly added claims 58-61 were
11 patentable. The reexamination proceedings concerning the '316 patent, including any appeals,
12 are completed, and the reexamination decision is final.

13 **U. S. Patent No. 7,371,075**

14 Lotes has filed two reexamination requests for U.S. Patent No. 7,371,075 ("the '075
15 Patent"). Lotes filed the first Reexamination Request on February 1, 2011, as Ex Parte
16 Reexamination No. 90/009,873. The examiner issued a Reexamination Certificate for the '075
17 Patent on November 22, 2011. The examiner determined that claims 2, 3, and 5 were patentable
18 as amended, and claims 1 and 4 were cancelled. The reexamination proceedings pursuant to this
19 request has concluded.

20 Lotes filed the second Reexamination Request for the '075 Patent on November 7, 2011,
21 as Ex Parte Reexamination No. 90/012,004. In its Advisory Action Before Filing of an Appeal
22 Brief of September 13, 2012, the examiner rejected the remaining claims, 2, 3, 5, and newly
23 added claims 8-12. Foxconn cancelled claims 6 and 7.

24 Foxconn filed a Notice of Appeal on September 28, 2012 and filed its Appeal Brief on
25 November 27, 2012. The examiner filed an Answer to Foxconn's Appeal Brief on April 9, 2013
26 arguing that the rejections should be sustained. Foxconn filed its Reply Brief on June 5, 2013.
27 Presently, claims 1, 4, 6 and 7 are cancelled, claims 2, 3, and 5 are rejected, and newly added
28 claims 8-12 are rejected. The examiner's decision was affirmed on appeal. On March 28, 2014,

1 Foxconn filed a request for rehearing. On June 23, 2014, the examiner's decision was affirmed
2 after consideration of the request for rehearing. Foxconn filed a notice of appeal on August 22,
3 2014. Foxconn subsequently dismissed its appeal on December 1, 2014. Thus, the reexamination
4 proceedings concerning the '075 patent, including any appeals, are completed.

5 Foxconn filed a reissue request on October 21, 2014, requesting reissue of claims 2, 3, and
6 5-12, as amended. On January 16, 2015, the firm of Sheppard Mullin Richter & Hampton LLP
7 filed a Protest under 37 CFR 1.291, arguing that certain claims should be struck from Foxconn's
8 reissue application. The parties are awaiting the first office action.

9 **LICENSED PATENTS**

10 **U.S. Patent No. 6,340,309**

11 Lotes filed its Second Amended Complaint on June 6, 2013, which seeks a declaration of
12 non-infringement of the Licensed Patents, including U.S. Patent No. 6,340,309 ("the '309
13 Patent"). Foxconn filed its Second Amended Answer and Counterclaims on June 20, 2013, which
14 include a claim for infringement of the '309 Patent. On August 12, 2013, Lotes filed a Motion to
15 Stay the '309 patent pending reexamination, which the Court granted in an order entered on
16 November 13, 2013. All claims of the '309 Patent are presently stayed pursuant to the Court's
17 November 13, 2013 Order.

18 Lotes filed a Reexamination Request for U.S. Patent No. 6,340,309 on June 12, 2013, as
19 Ex Parte Reexamination No. 90/012,891. The examiner issued a non-final office action on
20 December 13, 2013, rejecting claims 1-9. Foxconn's filed a response to the Office Action on
21 February 13, 2014. The examiner issued a final office action on June 4, 2014, rejecting claims 1-
22 25. Foxconn filed a response to the Office Action on August 4, 2014. The examiner issued an
23 advisory office action on August 15, 2014, maintaining the rejection of claims 1-25. Foxconn
24 filed an Appeal Brief on December 3, 2014, in response to the Final Office Action and the
25 Advisory Action to appeal the rejection of claims 1-25. The Examiner mailed the Examiner's
26 Answer on February 4, 2015. A reply brief was filed on April 6, 2015. The parties are currently
27 awaiting a decision by the PTAB.
28

U. S. Patent No. 6,887,114

The '114 Patent is not one of the patents with respect to which claims are stayed pursuant to the Court's January 4, 2012 Order or the Court's November 13, 2013 Order. Lotes has filed two reexamination requests for U.S. Patent No. 6,887,114 ("the '114 Patent").

Lotes filed the first Reexamination Request on August 22, 2012, as Ex Parte Reexamination No. 90/012,447. The examiner issued a non-final office action on October 9, 2013, rejecting claims 1-40. Foxconn filed a response to the office action on January 10, 2014, through which claims 1, 5, and 9 were amended and new claims 21-45 added. The examiner issued a final office action on May 7, 2014, rejecting claims 1-45. Foxconn filed a response to the Office Action on July 7, 2014. The examiner issued an advisory office action on August 1, 2014, maintaining the rejection of claims 1-45. Foxconn filed an Appeal Brief on November 5, 2014, in response to the Final Office Action and the Advisory Action to appeal the rejection of claims 1-45. The Examiner mailed the Examiner's Answer on December 40, 2014. A reply brief was filed on February 27, 2015. The parties are currently awaiting a decision by the PTAB.

Lotes filed a second Reexamination Request for '114 patent on October 17, 2012, as Ex Parte Reexamination No. 90/012,705. Lotes sought reexamination of claims 1-20 of the '114 Patent based on additional references. Lotes recommended to the Patent Office that the second Reexamination be associated with the first Reexamination. The Patent Office denied the request for the second Reexamination on January 16, 2013, on the grounds the same issues were presented in the first Reexamination Request. Lotes filed a petition to reverse the denial on February 15, 2013. The Patent Office denied the request for the second Reexamination for a second time on July 12, 2013, thereby terminating the reexamination proceeding.

U. S. Patent No. 6,908,313

Lotes filed its Second Amended Complaint on June 6, 2013, which seeks a declaration of non-infringement of the Licensed Patents, including U.S. Patent No. 6,908,313 ("the '313 Patent"). Foxconn filed its Second Amended Answer and Counterclaims on June 20, 2013, which include a claim for infringement of the '313 Patent. The '313 Patent is not one of the patents with

1 respect to which claims are stayed pursuant to the Court's January 4, 2012 Order or the Court's
2 November 13, 2013 Order.

3 Lotes filed a Reexamination Request for '313 patent on August 14, 2013, as Ex Parte
4 Reexamination No. 90/012,953. The Patent Office granted the request on October 2, 2013. The
5 examiner issued a non-final office action on July 22, 2014, rejecting claims 1-17. Foxconn filed a
6 response to the office action on September 22, 2014. The examiner issued a final office action on
7 January 5, 2015, rejecting claims 1-46. Foxconn filed a response to the Office Action on March
8 5, 2015. The examiner issued an advisory office action on March 23, 2015, maintaining the
9 rejection of claims 1-46. Foxconn filed a notice of Appeal on April 6, 2015.

10 This report is provided solely to inform the Court with respect to the status of
11 reexamination proceedings. Nothing contained herein constitutes an admission or concession by
12 any party with respect to the validity or invalidity of any patent or claim of a patent, and this
13 report is not admissible in this action or in any other proceeding as evidence of such an admission
14 or concession.

15 Dated: April 20, 2015

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22 Dated: April 20, 2015

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ATTORNEY'S E-FILING ATTESTATION

As the attorney e-filing this document, and pursuant to General Order 45, I hereby attest that counsel for Plaintiff/Counterclaim Defendant Lotes Co., Ltd. whose electronic signature appears above, has concurred in this filing.

Dated: April 20, 2015

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